UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,114	09/04/2001	Christopher Andrew Barton	01.112.01	2442

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EXAMINER
MITCHELL, JASON D

ART UNIT	PAPER NUMBER
2193	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/944,114</td><td>Applicant(s)
BARTON ET AL.</td><td></td></tr>
<tr><td>Examiner
Jason Mitchell</td><td>Art Unit
2193</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*17 October 2005*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-6,10,11,14-16,20,21,24-26 and 30* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-6,10,11,14-16,20,21,24-26 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

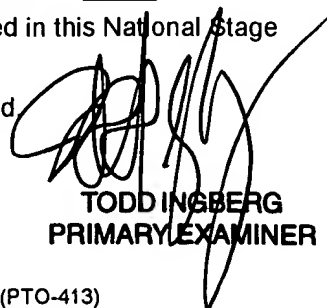8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

TODD INGBERG
PRIMARY EXAMINER

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date <u>*10/17/05*</u>.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

This action is in response a request for continued examination filed on 10/17/05.

At Applicant's request, claims 1, 11 and 21 are amended and claims 2-3, 7, 12-13, 17,

22-23 and 27 have been canceled. Claims 1, 4-6, 10-11, 14-16, 20-21, 24-26 and 30

are pending in this case.

Response to Arguments

Applicant's arguments on pp. 8-10 regarding the prior art rejection of claims 1, 11

and 21 have been fully considered but they are not persuasive.

Starting in the 3rd paragraph on pg. 8 Applicant states:

> Specifically, in response to applicant's latest arguments and amendments, the
> Examiner has relied on col. 2, line 2 from Cheng to meet applicant's claimed
> "sending a tag indicative of availability of said updated computer file to said
> database of computers" (see this or similar, but not necessarily identical language in
> each of the independent claims). In particular, the Examiner relies on the "record
> from the update table" to meet applicant's claimed "tag indicative of availability of
> said updated computer file."
> However, it appears that the Examiner has not fully considered the context of such
> record in Cheng. As noted from the Cheng excerpt below, such "record from the
> update table" of Cheng is sent to <u>users</u>.
> ...
> Thus, it is clear that contrary to Examiner arguments, Cheng does not meet
> applicant's claimed "sending a tag indicative of availability of said update computer
> file to said database of computers".

Respectfully, Applicant does not specifically point out how the language of the claims

patentably distinguishes them from the references. Examiner's understanding of

Applicant's position is that the claimed 'tag' is actually sent to a database and not to a

computer, which uses the file to be updated. This has not been Examiner's

understanding of the claim.

In light of Applicants disclosure in the specification (for example pg. 12, lines 5-20 'a

system sends an e-mail message to a *client workstation* 14 to trigger updating of a

computer file' emphasis added), the claim language is being interpreted to recite the

limitation of sending a tag to a computer, listed in a database of computers, which will

ultimately receive the update. This interpretation is more in keeping with Applicant's

disclosure and the 'similar ... language in each of the [other] independent claims', which

each clearly state 'send a tag ... to said computer' and not to a 'database'.

With this interpretation in mind, it is clear that Cheng does send a tag (col. 19, line 67-

col. 20, line 4 'The email contains ... the record from the update table 807') indicative of

availability of said update computer file (col. 19, lines 54-57 'notifications about new

updates') to said database of computers (col. 19, lines 50-54 'The user profile database

711').

In the first paragraph on pg. 10, Applicant states:

> However, such excerpt simply discloses that a version is supplied by software
> vendors. It is noted above that the Examiner has relied on the record from the
> update table 807 (see Figure 8, and col. 20, line 2 et al.) to meet applicant's claimed
> "tag which is sent to a database of computers. However, inspection of Figure 8
> indicates that the record 807 does not include any version information. Thus, Cheng
> simply fails to meet <u>a tag sent to a database of computers</u>, wherein the <u>tag includes</u>
> data indicative of <u>a version level</u> of the computer file, as claimed.

Examiner respectfully disagrees. As can be seen by its brief description, Fig. 8 is simply

one embodiment of the invention, whereas col. 4, lines 51-60 of Cheng clearly states

'The update database ... Preferably ... including version information'. This disclosure

would certainly be sufficient to teach one of ordinary skill in the art to send a tag (col.

19, line 67-col. 20, line 4 'record from the update table 807'), which includes a version

level (col. 4, lines 51-60 'version information') of the computer file.

In the third paragraph on pg. 10, Applicant states:

> However, Neal merely discloses a tag in a header. As noted above, the Examiner
> has not made a prior art showing of applicant's claimed tag sent to a database of
> computers, wherein the tag includes data indicative of a version level of the
> computer file as claimed.

Respectfully, as discussed above, it is Examiner's position that Cheng does in fact

teach sending a tag to a database of computers said tag including a version level.

Claim Rejections - 35 USC § 112

**Claims 1, 4-6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being
indefinite for failing to particularly point out and distinctly claim the subject
matter which applicant regards as the invention.**

As a result of Applicant's remarks (pg. 8, paragraph 4) filed 10/17/05 Examiner is now

unclear exactly what limitations are intended by the recitation of 'sending a tag

indicative of availability of said updated computer file to said database of computers'.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 4, 7, 10-12, 14, 17, 20, 21-22, 24, 27, and 30 are rejected under 35

U.S.C. 103(a) as being unpatentable over Cheng et al, USPN: 6,151,643 (Cheng), in

view of Averbuch et al. USPN 5,896,566 (Averbuch), in view of Neal, USPN:

6,192,518 (Neal).

Regarding Claims 1, 11 and 21: Cheng teaches a method, computer program product,

and apparatus providing an updated version of a computer file at a location from which

it may be downloaded (col. 3, lines 14-15), and sending a tag (col. 20 line 2 'record from

the update table') indicative of availability of said updated computer file to said database

of computers; and maintaining said database (col. 17, lines 4-5) of computers to which

said tag is to be sent when an updated version of said computer file is made available,

wherein said database of computers includes priority data indicating a priority level

associated with an address (col. 20, lines 47-49), said priority level being used to control

how rapidly after said updated version of said computer file is made available said tag is

sent to said database of computers; wherein said tag contains data indicative of a

version level. (col. 4, lines 54-59); wherein said tag as part of an e-mail message (col.

19, lines 61-63).

Cheng does not teach said priority level controlling selection of one of a plurality of

different finite delay periods after said updated version of said computer file is made

available following, which said tag is sent to said database of computers.

Averbuch teaches said priority level controlling selection of one of a plurality of different

finite delay periods after said updated version of said computer file is made available

following which said tag is sent to said database of computers (col. 4, lines 62-67 'users

having higher priority will receive indication of the updated software before users having

lower priority') in an analogous art for the purpose of dispersing the work load on a

server when notifying clients of the availability of a download (col. 4, lines 62-67 'to

spread the loading placed on the server').

It would have been obvious to one of ordinary skill in the art at the time of the invention

to replace Cheng's 'all or nothing' priority list (col. 20, lines 47-49) with Averbuch's

plurality of different finite delay periods (col. 4, lines 62-67) because one of ordinary skill

in the art would have been motivated to disperse the work load on a server when

notifying clients of the availability of a download (col. 4, lines 62-67 'to spread the

loading placed on the server').

Further neither Cheng nor Averbuch teach including said tag as part of an e-mail

header. Cheng's invention requires users to manually connect to the server in order to

receive the updated file. This would be greatly improved by the automatic updating

described in Neal.

Neal teaches that said tag is part of an e-mail message header. (col. 5, lines 11-13)

Neal discloses placing the tag, in this case prefaced by the text "MBA 2.0" in the e-

mail's subject line, enabling an application running on the client to scan the in-box (See

fig. 2a, 210) and automatically detect the notification of the update's availability. Once

detected, the client application initiates the retrieval and update process.

It would have been obvious to a person of ordinary skill in the art at the time of the

invention to provide each of Cheng's client computers with the automatic detection and

response (col. 5, lines 9-13) aspects of Neal's invention, there by removing any reliance

on users to perform the updates in a timely manner and ensuring uniformity on the client

side as is desirable. (Neal col. 2 lines 25-30).

Regarding Claims 4, 14 and 24: The rejection of Claims 1, 11 and 21 are incorporated

respectively; further Cheng teaches a connection to said location via an Internet link

(col. 3, lines 13-15).

Regarding Claims 10, 20 and 30: The rejection of Claims 1, 11 and 21 are

incorporated respectively; further Cheng teaches a method, computer program product

and apparatus wherein sending of said tag upon availability of an updated version of

said computer file is provided as a subscription service. (col. 5, lines 22-23)

Claims 5, 6, 15,16, 25, and 26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cheng et al, USPN: 6,151,643 (Cheng) in view of Averbuch et

al. USPN 5,896,566 (Averbuch) as applied to claims 1,2,4,7,8-10, 11,12,14,17,18-20,

21,22,24,27,28-30 above, further in view of Hodges et al, USPN:

6,035,423(Hodges).

Regarding Claims 5, 6, 15, 16, 25, and 26: The rejection of Claims 1, 11 and 21 are

incorporated respectively; further, neither Cheng nor Averbuch teach using his invention

to update anti-virus software, but does state the scope of products that could be

updated as "various software products" (See Cheng col. 25, lines 15-17), and antivirus

software as described in Hodges certainly falls within this range.

Hodges teaches a method, computer program product and apparatus for the updating

of virus definition data, and anti-virus computer programs. (See Hodges Fig 7) Further,

Hodges notes that it is desirable to provide a method for providing the most up-to-date virus files to a client (col. 4, 26-39)

It would have been obvious to a person of ordinary skill in the are at the time of the invention to use Cheng's software updating method to ensure that clients had the most up-to-date anti-virus software installed as discussed in Hodges (See col. 4, lines 26-39). The modification would have been obvious because one of ordinary skill in the art would have been motivated to use Cheng's methods to ensure that users had timely notification of availability of an anti-virus software update (Hodges col. 3, lines 30-31) such as that disclosed by Hodges.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Jason Mitchell
11/02/05

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PRIMARY EXAMINER